



1241.18

JC Sec'd PCT/STO 29 NOV 2001

Box 5 eq

PATENT APPLICATION

# 8.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
MOTOHARU SEIKI	)	Examiner: Not Yet Assigned
Application No.: 09/806,232	)	Group Art Unit: N/Y/A
Application Submitted: March 28, 2001	)	
For: DNAS ENCODING NOVEL	)	
POLYPEPTIDES	)	November 27, 2001

Commissioner for Patents  
Washington, D.C. 20231

PETITION FOR EXTENSION OF TIME,  
RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE  
and  
SUBMISSION OF CORRECTED COMPUTER  
READABLE FORM UNDER 37 C.F.R. § 1.821(e)

Sir:

Applicants petition to extend the time for response to the Notification of a Defective Response dated September 14, 2001 to December 14, 2001. A check in the amount of \$400.00 for payment of the extension fee is enclosed. Please charge any additional fee required for the extension in connection with this paper, and credit any overpayment, to Deposit Account 06-1205.

Applicants respond to the NOTIFICATION OF DEFECTIVE RESPONSE mailed September 14, 2001 (form PCT/DO/EO/916) as follows. A copy of the

Notification is attached at Tab A.

12/06/2001 HNGUYEN 00000057 09806232

01 FC:116

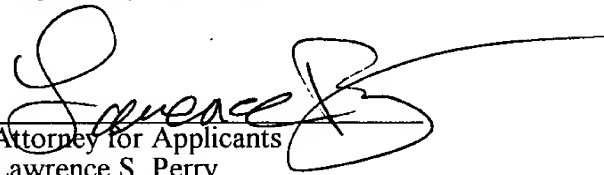
First, enclosed please find at Tab B a Submission of Corrected Computer

Readable Form under 37 C.F.R. § 1.821(e). The content of the computer readable form and the Sequence Listing filed herewith are the same. No new matter has been added.

Second, regarding the Notification of a Defective Oath or Declaration, the undersigned yesterday spoke with Anthony Smith, Petitions Attorney in PCT Legal Affairs. Mr. Smith confirmed that such Notification was issued erroneously and would be withdrawn.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our below listed address.

Respectfully submitted,

  
Attorney for Applicants  
Lawrence S. Perry  
Registration No. 31,865

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200

LSP\ac

NY\_MAIN 220258v1



## UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 19 2001

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/806232	SEIKI	M 1241.18
INTERNATIONAL APPLICATION NO.		
PCT/JP99/05349		
I.A. FILING DATE	PRIORITY DATE	
29 SEP 99	29 SEP 98	
DATE MAILED: 14 SEP 2001		

LAWRENCE S. PERRY  
FITZPATRICK, CELLA, HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

1241.18  
10/14/01  
9/19/01

## NOTIFICATION OF A DEFECTIVE RESPONSE

1. ☐ The request for an extension of time (37 CFR 1.136(a)) filed 5 is defective because the required fee is missing/insufficient. Extension of time fees are listed at 37 CFR 1.17(a)(1)-(a)(5).
2. ☐ Applicant's response filed \_\_\_\_\_ was received in the Office after the expiration of the period for response set in the Office notification mailed \_\_\_\_\_. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office notification under 37 CFR 1.136(a).
3. ☒ Applicant's response filed 18 JUL 2001 is hereby acknowledged. The following requirements set forth in the NOTIFICATION of MISSING REQUIREMENTS (Form PCT/DO/EO/905) mailed 30 MAY 2001 have not been completed.
- ☐ Translation of the international application into English.
    - ☐ which is defective for the reasons indicated on the attached Notice of Defective Translation.
  - ☐ Processing fee (37 CFR 1.492(f)).
  - ☒ Oath or Declaration of inventor(s).
    - ☒ not in compliance with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
  - ☐ Surcharge (37 CFR 1.492(e)).
  - ☒ Sequence Listing.
    - ☒ not in compliance with 37 CFR 1.821-1.825 for the reasons indicated on the attached PCT/DO/EO/920.
  - ☐ Additional claim fees.

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements (Form DO/EO/905), whichever is the longer. No extension of this time limit may be granted under 37 C.F.R. § 1.136, but the period for response set in the Notification of Missing Requirements (Form DO/EO/905) may be extended under 37 C.F.R. § 1.136(a).

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation  
☒ PCT/DO/EO/920

Shakeel Ahmed

Telephone: 703-305-3659



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231  
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NEW YORK NY 10112

DATE MAILED: 14 SEP 2001

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Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation  
☒ PCT/DO/EO/920

Shakeel Ahmed

Telephone: 703-305-3659

FORM PCT/DO/EO/916 (March 2001)



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231  
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LAWRENCE S PERRY  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK NY 10112

DATE MAILED: **14 SEP 2001****NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS  
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE  
DISCLOSURES**

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- ☒ The application fails to comply with the requirements of 37 CFR 1.821-1.825.
- ☐ This application does not contain, a "Sequence Listing" as a separate part of the disclosure on paper copy or compact disc, as required by 37 CFR 1.821(c).
- ☐ A copy of the "Sequence Listing" in computer readable format has not been submitted as required by 37 CFR 1.821(e).
- ☒ A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- ☐ The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ The paper copy or compact disc of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ Other: \_\_\_\_\_

**APPLICANT MUST PROVIDE:**

- ☒ An initial or substitute computer readable form (CRF) of the "Sequence Listing."
- ☐ An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- ☒ A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

**FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE  
CALL:**

(703) 308-4216, for Rules interpretation,  
(703) 308-4212, for CRF submission help,  
(703) 287-0200, for PatentIn software help.

Shakeel Ahmed

Telephone: 703-305-3659



## UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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LAWRENCE S. PERRY  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK NY 10112

DATE MAILED: 14 SEP 2001

**NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION**

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America. The period within which to correct the deficiency noted below and avoid abandonment is set in the accompanying Notification.

A new oath or declaration, properly identifying this application (preferably by the international application number and international filing date) is required. The oath or declaration does not comply with 37 CFR 1.497(a),(b) and (f) in that it:

1. ☒ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☒ does not identify the application to which it is directed. x Motoharu SEIKI  
✓ Motoji SEIKI (as published)
3. ☐ does not identify the inventor(s).
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

**FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b), AND 1.497(d) WHERE APPROPRIATE, WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.**

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the mailing address of each inventor. If the residence is different from the mailing address, then the city and state or city and foreign country of residence of each inventor must also be given.
2. ☐ does not state that the person making the oath or declaration:
  - a. ☐ has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
  - b. ☐ acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate for which a claim for priority is made pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.

Shakeel Ahmed

Telephone: 703-305-3659

Attorney's Docket No.: \_\_\_\_\_

**DECLARATION, POWER OF ATTORNEY**

I (We), the undersigned inventor(s), hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I (We) believe that I am (we are) the original, first, and joint (sole) inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled

DNAS ENCODING NOVEL POLYPEPTIDE S

the specification of which

☐ is attached hereto.

☒ was filed on March 28, 2001 as

Application Serial No. 09/806,232

and amended on \_\_\_\_\_.

☒ was filed as PCT international application

Number PCT/JP99/05349

on September 29, 1999,

and was amended under PCT Article 19

on \_\_\_\_\_ (if applicable).

I (We) hereby state that I (We) have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above; that I (We) do not know and do not believe that this invention was ever known or used before my invention or discovery thereof, or patented or described in any printed publication in any country before my invention or discovery thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that this invention or discovery has not been patented or made the subject of an inventor's certificate in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months before this application.

I (We) acknowledge the duty to disclose information known to be material to the patentability of this application as defined in Section 1.56 of Title 37 Code of Federal Regulations.

I (We) hereby claim foreign priority benefits under Section 119(a)-(d) of Title 35 United States Code, of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Application No.	Country	Filing date	Priority claimed
<u>276258/1998</u>	<u>Japan</u>	<u>September 29, 1998</u>	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
<u>291505/1998</u>	<u>Japan</u>	<u>September 29, 1998</u>	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No

I hereby claim the benefit under Section 119(e) of Title 35 United States Code, of any United States application(s) listed below.

\_\_\_\_\_  
(Application Number)

\_\_\_\_\_  
(Filing Date)

\_\_\_\_\_  
(Application Number)

\_\_\_\_\_  
(Filing Date)

I (We) hereby claim the benefit under Section 120 of Title 35 United States Code, of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Section 112 of Title 35 United States Code, I (We) acknowledge the duty to disclose material information as defined in Section 1.56(a) of Title 37 Code of Federal Regulations, which occurred between the filing date of the prior application and national or PCT international filing date of this application:

Application Serial No.	Filing Date	Status (pending, patented, abandoned)
_____	_____	_____
_____	_____	_____
_____	_____	_____



And I (We) hereby appoint: Joseph M. Fitzpatrick, Registration No. 17,398; Lawrence F. Scinto, Registration No. 18,973; William J. Brunet, Registration No. 20,452; Robert L. Baechtold, Registration No. 20,860; John A. O'Brien, Registration No. 24,367; John A. Krause, Registration No. 24,613; Henry J. Renk, Registration No. 25,499; Peter Saxon, Registration No. 24,947; Anthony M. Zupcic, Registration No. 27,276; Charles P. Baker, Registration No. 26,702; Stevan J. Bosses, Registration No. 22,291; Edward E. Vassallo, Registration No. 29,117; Ronald A. Clayton, Registration No. 26,718; Lawrence A. Stahl, Registration No. 30,110; Laura A. Bauer, Registration No. 29,767; Leonard P. Diana, Registration No. 29,296; David M. Quinlan, Registration No. 26,641; Nicholas N. Kallas, Registration No. 31,530; William M. Wannisky, Registration No. 28,373; Lawrence Alaburda, Registration No. 31,583; Lawrence S. Perry, Registration No. 31,865; Robert H. Fischer, Registration No. 30,051; Christopher Philip Wrist, Registration No. 32,078; Gary M. Jacobs, Registration No. 28,861; Michael K. O'Neill, Registration No. 32,622; Bruce C. Haas, Registration No. 32,734; Scott K. Reed, Registration No. 32,433; Scott D. Malpede, Registration No. 32,533; John A. Mitchell, Registration No. 19,032; Fredrick M. Zullo, Registration No. 32,452; Richard P. Bauer, Registration No. 31,588; Warren E. Olsen, Registration No. 27,290; Abigail F. Cousins, Registration No. 29,292; Jennifer A. Tegfeldt, Registration No. 31,310; Steven E. Warner, Registration No. 33,326; Thomas J. O'Connell, Registration No. 33,202; Aaron C. Deditch, Registration No. 33,865; Penina Wollman, Registration No. 30,816; David L. Schaeffer, Registration No. 32,716; Jack S. Cubert, Registration No. 24,245; Mark A. Williamson, Registration No. 33,628; John T. Whelan, Registration No. 32,448; Patricia M. Drost, Registration No. 29,790; Jean K. Dudek, Registration No. 30,938; Raymond R. Mandra, Registration No. 34,382; Dominick A. Conde, Registration No. 33,856; Steven C. Bauman, Registration No. 33,832; Pasquale A. Razzano, Registration No. 25,512; John W. Behringer, Registration No. 23,086; Robert C. Kline, Registration No. 17,739; Carolyn H. Blankenship, Registration No. 35,449; Richard F. Jaworski, Registration No. 33,515; Lawrence W. Nelson, Registration No. 34,684; Benjamin C. Hsing, Registration No. 34,528; Leo J. Jennings, Registration No. 32,902; Mark J. Itri, Registration No. 36,171; William C. Hwang, Registration No. 36,169; and John C. Phillips, Registration No. 35,322.

I(We) hereby request that all correspondence regarding this application be sent to the firm of FITZPATRICK, CELLA, HARPER & SCINTO whose Post office address is: 30 Rockefeller Plaza, New York, N.Y. 10112-3801 U.S.A.

I, Motoharu SEIKI, of Koyamadai-jutaku 5-203, 2-5, Koyamadai, Shinagawa-ku, Tokyo 142-0061 Japan hereby declare under 37 C.F.R. § 1.132 as follows:

In general, Kanji characters have a few different phonetic pronunciations. In this regard, the Kanji character for Motoharu is the same as the Kanji character for Motoji. PCT application PCT/JP99/05349 was submitted with the correct Kanji character for Motoharu.

The Kanji character was mistranslated by the PCT in Geneva and printed as "Motoji" in WO00/18900. However, the Kanji character was correctly translated as "Motoharu" in the 09/806,332 application papers.

I (We) declare further that all statements made herein of my (our) knowledge are true and that all statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Motoharu SEIKI

NAME OF FIRST SOLE INVENTOR

Motoharu Seiki

Signature of Inventor

July 6, 2001

Date

Residence: Tokyo, Japan

\_\_\_\_\_

Citizen of: Japan

Post Office Address:

Koyamadai-jutaku 5-203, 2-5,

Koyamadai. Shinagawa-ku,

Tokyo 142-0061 Japan

\_\_\_\_\_